

REMARKS

Claims 1-7 are currently pending in the present application. Claims 3, 4 and 7 have been withdrawn from further consideration as being drawn to a nonelected invention.

Claim 1 is the only independent claim. Claim 1 has been amended to more clearly recite a fabric protectant composition that comprises (i) an ester compound of formula (1), (ii) 2,4,6-triisopropyl-1,3,5-trioxane, and (iii) a film selected from the group consisting of polyethylene having 0.91 to 0.94 g/cm³ of density, copolymer of ethylene and vinyl acetate, and copolymer of ethylene and methyl metacrylate, and that the ester compound and 2,4,6-triisopropyl-1,3,5-trioxane are enveloped in the film. Claims 2-7 are amended to be consistent with the amended claim 1. Support for the claim amendments is found at least from original claim 1 and Production Examples 1-14 of the specification.

The amendments do not add any new matter to the application, entry of the amendments is respectfully requested.

Claim Rejections Under 35 U.S.C. §102

The Examiner has rejected claims 1 and 2 under 35 U.S.C. §102(b) as being anticipated by Sugano (EP 962140) ("Sugano") for reasons cited in the previous action. In response to Applicants' arguments filed with the USPTO on 12/03/20007, the Examiner points out that Sugano taught the 2,2-dichlorovinyl fabric protectant at ¶27 on the last line of page 5. The Examiner suggests that if Applicants wish to claim the film comprising the fabric protectant, Applicants should claim said film.

Without acquiescing to the Examiner's reasoning, claim 1 has been amended to clearly recite the film as part of the fabric protectant composition. The film is selected from the group consisting of polyethylene having 0.91 to 0.94 g/cm³ of density, copolymer of ethylene and vinyl acetate, and copolymer of ethylene and methyl metacrylate. Applicants respectfully submit that, upon entry of the claim amendment, the claims are directed to a fabric protectant composition that comprises at least three components: (i) an ester compound of formula (1), (ii) 2,4,6-triisopropyl-1,3,5-trioxane, and (iii) the film. In the composition, the ester compound of formula (1) and 2,4,6-triisopropyl-1,3,5-trioxane are enveloped in the film.

Sugano does not anticipate claims 1 and 2, at least because Sugano does not teach or suggest to use a film in a manner as recited in claim 1 in a fabric protectant composition. Sugano discloses "speading, soaking, fogging, dripping or kneading the inventive fabric protectant into or onto the components of household containers or chambers, such as closets, to allow the fabric

protectant to be preserved or contained in said components,” see ¶25, line 4-6. Applicants respectfully point out that the household containers or chambers of Sugano is structurally and functionally different from the film recited in claim 1; and that “speading, soaking, fogging, dripping or kneading” a fabric protectant “into or onto the components of household containers or chambers” is very different from enveloping the fabric protectant in the film. In addition, although Sugano indicates that polyethylene and several other materials can be used to produce the household containers or chambers, it does not contain any description about the “0.91 to 0.94 g/cm³ of density” of polyethylene recited in claim 1.

Accordingly, Sugano does not anticipate claim 1. Sugano also does not anticipate claim 2, because claim 2 depends on claim 1. Reconsideration and withdrawal of the rejection of claims 1 and 2 under 35 U.S.C. §102(b) as being anticipated by Sugano are respectfully requested.

The Examiner has rejected claims 1, 2 and 5 under 35 U.S.C. §102(b) as being anticipated by Aoki (JP2000355510) (“Aoki”).

Aoki does not anticipate claims 1, 2 and 5, at least because Aoki does not teach or suggest to use a film in a manner as recited in claim 1 as part of its fabric protectant composition. Aoki discloses that an active ingredient, such as 2,3,5,6-tetrafluoro-4-methylbenzyl 3-(2,2-dichlorovinyl)-2,2-dimethyl-cyclopropanecarboxylate, can be mixed with a sublimable compound, such as 2,4,6-triisopropyl-1,3,5-trioxane, see paragraph [0016]. However, it does not teach or suggest to use a film recited in claim 1 to envelope the active ingredient and the sublimable compound in the fabric protectant composition.

Accordingly, Aoki does not anticipate claims 1, 2 and 5. Reconsideration and withdrawal of the rejection of claims 1, 2 and 5 under 35 U.S.C. §102(b) as being anticipated by Aoki are respectfully requested.

The Examiner has also rejected claims 1, 2, 5 and 6 under 35 U.S.C. §102(a) as being anticipated by Tsushima (US 2005/0137250) (“Tsushima”).

For reasons similar to those discussed above under Aoki, Tsushima does not anticipate claims 1, 2, 5 and 6, at least because it does not teach or suggest to use a film in a manner as recited in claim 1 as part of its fabric protectant composition. Reconsideration and withdrawal of the rejection of claims 1, 2, 5 and 6 under 35 U.S.C. §102(a) as being anticipated by Tsushima are respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

The Examiner has rejected claims 5 and 6 under 35 U.S.C. §103(a) as being unpatentable over Sugano in combination with Tsushima or Takagawa et al. (JP 2002320544) (“Takagawa”) for reasons cited in the previous action. In response to Applicants’ arguments filed with the USPTO on 12/03/20007, the Examiner points out that one cannot show nonobviousness by attacking secondary references individually, and that Applicants’ arguments amount to a general allegation of non-obviousness, without specifically pointing out why the combination of references would not render the rejected claims obvious.

Without acquiescing to the Examiner’s reasoning, Applicants respectfully submit that upon entry of the present claim amendments, the cited references do not render claims 5 and 6 obvious, at least because the references, alone or in combination, do not teach or suggest to use a film in a manner as recited in claim 1 as part of a fabric protectant composition.

As discussed in the Background Art of the present application, although fabric protectant is generally used in a package for preventing damages of fabric, the effect of fabric protectant may decrease by absorption of the active ingredient in the fabric protectant into the envelope. The present application teaches, e.g., by comparative tests in Test Example 4, that enveloping an ester compound of formula (1) and 2,4,6-triisopropyl-1,3,5-trioxane in a film as that recited in claim 1, did not decrease the fabric protection effect of the present fabric protectant, rather it increased the fabric protection effect at early stage, see Table 4. The presently amended claims clearly recite the film as part of the fabric protectant composition.

As discussed above, neither Sugano nor Tsushima teaches or suggests to use a film in a manner as recited in claim 1 in their fabric protectant compositions. Takagawa fails to compensate for the defects of Sugano, because Takagawa also does not teach or suggest to use a film in a manner as recited in claim 1 in its fabric protectant composition. Takagawa directs to a mothproof cover for clothing, which comprises a front sheet of plastics and a back sheet of a nonwoven fabric containing volatile pyrethroids and nonvolatile insecticides.

As the Court of Appeals for the Federal Circuit stated recently, a flexible teaching, suggestion or motivation (TSM) test remains the primary guarantor against a non-statutory hindsight analysis. Ortho-McNeil Pharmaceutical, Inc. v. Mylan Labs, 520 F.3d 1358, ___, 86 USPQ2d 1196, ___, 2008 US. LEXIS 6786, 14-15 (Fed. Cir. 2008). The cited prior art references, alone or in combination, fail to provide any TSM or other reasonable basis for one skilled in the art to make and use a fabric protectant composition that comprises a film in a

manner as recited in claim 1 with a reasonable expectation that the film would increase the fabric protection effect at early stage. Without such a fair basis, the obviousness rejection must be merely based on hindsight. A rejection based on hindsight has never been proper.

Accordingly, Sugano in combination with Takagawa does not render claim 1, and its dependent claims, such as claims 5 and 6, *prima facie* obvious. Reconsideration and withdrawal of the rejection of claims 5 and 6 under 35 U.S.C. §103(a) as being obvious over Sugano in view of Takagawa are respectfully requested.

For reasons discussed above, claim 1 and its dependent claims 2, 5 and 6 are not anticipated or rendered obvious by the cited prior art references, alone or in combination, thus are allowable. The Examiner has pointed out that claim 1 is generic to genii I and II. Upon the allowance of the generic claim 1, Applicants respectfully request rejoinder of additional species claims 3, 4 and 7 for examination on the merits. Because claims 3, 4 and 7 depend from or otherwise require all the limitations of the allowable generic claim 1, Applicants respectfully submit that claims 3, 4 and 7 are also allowable in view of the above discussions.

It is respectfully submitted that the present application, including currently pending claims 1-7, is in condition for allowance and such action is respectfully requested.

Respectfully submitted,

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